

REMARKS

This amendment is submitted in response to the Office Action mailed October 25, 2004. Although the Examiner indicated that claims 4-11 are pending in this application, claims 1-9 are actually pending in this application. The Applicants point out that on April 22, 2004 a Response to Notice of Incomplete Nonprovisional Application Under 37 CFR 1.53(b) was filed that included the pending claims 1-9. Additionally the Applicants would like to point out that the previous Action contained a Restriction Requirement directed to claims 1-9. Therefore, claims 1-3, and 8-9 are pending in this application. Claims 4-7 were withdrawn from this application as a result of an earlier restriction requirement.

Claim Rejection Under 35 U.S.C. 112

On page 2 of the Office Action the Examiner rejected "claims 8-11 under 35 U.S.C 112, first and second paragraphs, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." The Applicants respectfully traverse. The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation. *United States v Telectronics, Inc.*, 857 F. 2d 778, 785, 8 USPQ2d 1217, 1233 (Fed. Cir. 1988) and MPEP 2164.01.

In the Office Action, the Examiner asks, "what is a sufficient width to accommodate means for serially cutting... or sufficiently large to allow a tool...to define...on a single machine set up?" The Applicants' response is that there is more than sufficient enablement in the claims and disclosure for one skilled in the art of measuring

erosion grooves on motors to clearly and exactly understand how to make and use the invention. The Examiner's concerns with using the word "sufficient" are unfounded because one skilled in the art would know how to use the term "sufficient" by reading the claims in conjunction with the specification and using the plain meaning of the word "sufficient." For example, the specification states, on page 2 lines 16-18, that "to simplify fabrication of this integral hub piece, the opening between the upper and lower female cones in this hub has sufficient width or radial dimension to allow access to both cones from one side of the hub with the cutting tool." This statement is enough for one skilled in the art to interpret the word "sufficient" so as to clearly, precisely and exactly make and use the claimed invention. Therefore the Applicants submit that the test for enablement, which is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation, has been met and request that the Examiner reconsider his rejection and allow the claims.

In the Office Action the Examiner also asks, "how thin is a hub opening...axially thin enough that the narrow ends of the conical elements can be directly formed together?" This limitation is not present in any of the remaining claims 1-3, and 8-9. Therefore, the Applicants respectfully request that the Examiner withdraw this rejection.

Therefore in light of these remarks the Applicants respectfully request that the Examiner withdraw his rejection of the pending claims under 35 U.S.C 112, first and second paragraphs.

Claim Rejection Under 35 U.S.C. 102(b)

On pages 2-3 of the Office Action the Examiner rejected claims 8-11 under 35 U.S.C. 102(b) as being anticipated by Kim because "the Examiner finds all claimed subject matter to be present." The Examiner further stated "the elements involved are integral as assembled. (See col. 4, lines 10-11)" The Applicants respectfully traverse. "Under 35 U.S.C. § 102, anticipation requires that each and every element of the claimed invention be disclosed in a prior art reference" *Akzo N.V. v. U.S. Int'l Trade Comm'n*, 808 F.2d 1471, 1 USPQ2d 1241 (Fed. Cir. 1986), *cert. denied*, 482 U.S. 909 (1987). **Nowhere** does Kim (US Patent 5,947,608) disclose each and every element of the claimed invention.

Kim does not teach or suggest each and every element of "a dual conical fluid dynamic bearing comprising an integral male cone/shaft element, an integral male cone/bore element, an integral single piece hub having first and second female cones defined therein and joined by a central opening, said male cone/shaft element and said male cone/bore element being joined through said central opening and supported by a fluid for relative rotation." The Examiner's assertion that the elements involved are integral as assembled and references col. 4, lines 10-11, which reads,

The cones 80 and 85 are fixed at the fixing shaft 20 to face each other. At the tapered surface of the cones 80 and 85, a dynamic pressure generating groove of the spiral shape is formed,

does not show where or how each and every element of the claimed invention is disclosed by Kim. Therefore the Applicants submit that the Examiner has not established anticipation under 35 U.S.C. § 102 and respectfully request that the Examiner withdraw his rejection of the pending claims under 35 U.S.C. § 102.

Rejection Under Judicially Created Doctrine of Obviousness-Type Double Patenting

In page 3 of the Office Action, the Examiner rejected claims 8-11 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6755570. The Applicants traverse this rejection. The Applicants do not agree with the Examiner that any of the pending claims of this application and claim 1 of U.S. Patent No. 6755570 "are not patentably distinct from each other because they differ only with respect to matters of wording or verbal surplusage." Nevertheless, in order to expedite prosecution the Applicants have prepared a terminal disclaimer in compliance with 37 CFR 1.321(c), as suggested by the Examiner.

Therefore, in light of the terminal disclaimer the Applicants respectfully request that the Examiner withdraw his rejection of the pending claims under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6755570.

Conclusion

In light of the above remarks, this application should be considered in condition for allowance and the case passed to issue. If there are any questions regarding these remarks or the application in general, a telephone call to the undersigned would be appreciated to expedite prosecution of the application.

In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection

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excess fees to such deposit account.

Respectfully submitted,

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(Assignee of Entire Interest)

12/8/2004
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